

action also concedes Lambert fails to disclose a fruit juice beverage, a fruit flavoring, sweeteners, or a dairy product. The office action cites Skeffington for purportedly teaching the above features not disclosed in Lambert. However, Applicant respectfully disagrees.

Skeffington describes pharmaceutical formulations that include water soluble Vitamin E. As explained on page 2, lines 9-12, Skeffington is concerned with making TPGS containing pharmaceutical formulations that include preservatives such that the resulting formulation has a shelf life "suitable for its intended use." To achieve such a formulation, Skeffington employs a preservative system that includes, for example, potassium sorbate, propyl paraben, methyl paraben, EDTA and/or propylene glycol. Skeffington also employs citric acid and sodium citrate as a buffering system. See Page 13, Line 11 through Page 14, Line 10. Unlike the present invention, however, Skeffington fails to teach or fairly suggest a beverage that includes a sweetener (as recited in claims 1 and 34); a flavoring agent (as recited in claims 1, 12, 23, and 34); fruit juice (as recited in claim 12); carbonated water (as recited in claim 23); or milk (as recited in claim 38).

Applicant notes the office action's assertion that Skeffington discloses such features and points to claim 6, claim 38, page 3, lines 1-35, page 7, lines 20-30, and page 16, lines 1-11 in Skeffington as disclosing the above noted features. However, claim 6 states a specific range of one of the preservatives. Since, Skeffington only includes 18 claims, claim 38 does not exist. Page 3 of Skeffington discloses two formulations that include only the Vitamin E, the preservatives, the buffering system, and distilled water. Page 7 shows the antibacterial effects of the formulations. Furthermore, page 16 includes claims 1-5, none of which list any of the ingredients of the presently claimed invention discussed above. In short, Applicant respectfully submits, for at least the above reasons, the combined teaching of Lambert and Skeffington fail to teach or fairly suggest each and every feature of the claimed invention.

Krasavage, Traber, and Argao all fail to remedy the deficiencies discussed above with respect to Lambert and Skeffington. Krasavage is concerned with studying the toxicity of TPGS on rats. Traber and Argao are concerned with producing a medicinal formulation that includes Vitamin E which can be administered orally for the treatment of cholestasis. Traber's formulations include tocopheryl acetate, polysorbate, MCT oil and water. Argao teaches administering Vitamin D₃ or a combination of Vitamin D₃ with TPGS. See abstract. None of these three documents teach or fairly suggest a beverage that includes a sweetener, a flavoring agent, fruit juice, carbonated water or milk. Moreover, there is nothing in the combined teachings of all of all of the cited documents which would have motivated one of ordinary skill in the art to produce a Vitamin E containing beverage having the above listed ingredients. Hence, the combined teachings of the listed documents fail to render the claimed invention obvious.

The Office Action labels the present invention as a recipe, and then cites *In re Levin* and asserts the Levin decision essentially states a *per se* rule that recipes are not patentable. However, Applicants respectfully disagree and provide the following comments. Applicant points out the following comments were taken from Ex parte Earl L. Johnson, unpublished Appeal No. 1997-2562. While this is non-binding precedent, the Board does provide guidance with respect to this issue.

The decision of *In re Levin*, 178 F.2d 945, 948, 84 USPQ 232, 234 (CCPA 1949), provides no basis for the application of a *per se* rule. The court made it clear in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) that there are no *per se* rules when determining obviousness under 35 U.S.C. § 103. As stated in *Ochiai*, 71 F.3d at 1572, 37 USPQ2d at 1133:

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention-including all its limitations with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific

analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966)] and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any *per se* rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract *per se* rules from decisions that disavow precisely such extraction.

To paraphrase the court in *Ochiai*, at 71 F.3d at 1570, 37 USPQ2d at 1132, there are not [Levin] obviousness rejections . . . but rather only section 103 obviousness rejections.

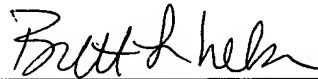
In order to properly determine whether the subject matter of a claim as a whole would have been obvious, an examiner's office action must explicitly address the *Graham v. John Deere Co.*, criteria for *prima facie* obviousness in the office action. Those 4 criteria cannot be circumvented by resort to a *per se* rule. In addition, care must be exercised in citing caselaw predating *Graham v. John Deere Co.*, on the issue of obviousness. While *In re Levin*, contains language about recipes, there also was evidence in that case "that the cited patents showed it was old in the making of butter substitute compositions to use edible acids, gums, starch, and egg yolk, and to use them together in the customary way and for the same purpose as they were used by appellant." See *In re Levin*. The point remains that *Graham v. John Deere Co.*, and its progeny are controlling on the requirements for establishing a *prima facie* case of obviousness. As set forth in *In re Cofer*, 354 F.2d 664, 667, 148 USPQ 268, 271 (C.C.P.A. 1966):

Necessarily, it is facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. 103. Merely stating that a compound or composition is obvious, without adequate factual support, is not sufficient.

In view of the above remarks, Applicant submits this rejection is overcome and respectfully requests it be withdrawn.

In summary, Applicant believes the application to be in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection and pass the application to issuance.

Respectfully submitted,



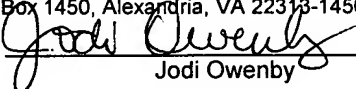
Brett L Nelson
Registration No. 48,119

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Date

Eastman Chemical Company
P.O. Box 511
Kingsport, Tennessee 37662
Phone: (423) 229-1652
FAX: (423) 229-1239

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Jodi Owenby

August 14, 2006
Date